

AMENDMENT UNDER 37 C.F.R. § 1.111
Application No. 10/052,911

Attorney Docket No. QI 8203

AMENDMENTS TO THE DRAWINGS

Fig. 9 is labeled "related art".

Attachment: One Replacement Sheet (1)

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REMARKS

Claims 1-16 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 4 and 5. The amendments to claims 4 and 5 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 4 and 5 were not made for reasons of patentability.

In addition, Applicant adds claims 7 to 16. Claims 7 to 16 are clearly supported throughout the specification *e.g.*, Fig. 8; pages 5-7 and 11-13.

I. Summary of the Office Action

The Examiner objected to the drawings and the specification. In addition, the Examiner rejected claims 1-6 under 35 U.S.C. § 102(e).

II. Preliminary Matters

Applicant thanks the Examiner for acknowledging the claim for foreign priority. The Examiner, however, failed to acknowledge the receipt of the certified copy of the priority document filed on March 15, 2002, in response to "Notice of Missing Parts". Therefore, it is appropriate and necessary for the Examiner to check the appropriate box on the Form PTO-126 indicating that the certified copy of the priority document has been received.

Moreover, the Examiner has not indicated the receipt or the consideration of the references listed on form listed on form PTO/SB/08 A & B submitted with the Information Disclosure Statement filed on April 23, 2004. Therefore, it is respectfully requested that the Examiner acknowledge receipt of the Information Disclosure Statement filed on April 23, 2004.

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and initial and return a copy of the Form PTO/SB/08 A & B. For Examiner's convenience, a copy of the Form PTO/SB/08 A & B as filed on April 23, 2004 is enclosed.

III. Objection to the Drawings

The Examiner objected to the drawings filed January 23, 2002, because they are informal. Applicant respectfully submits that the formal drawings were filed on March 15, 2002. As a result, the Examiner is respectfully requested to acknowledge receipt of the formal drawing and indicate approval of the drawing in the next Patent Office paper.

Moreover, by this amendment, Applicant labels Fig. 9 "related art." A Replacement Sheet is accompanying this response.

IV. Objection to the Specification

The Examiner also objected to the title for being not descriptive. Applicant herein amends the title. In view of this self-explanatory amendment to the title, it is appropriate and necessary for the Examiner now to withdraw this objection.

In addition, Applicant amends first full paragraph on page 12 of the specification and first full paragraph on page 16 of the specification to fix minor informalities. No new matter is being added.

V. Claim Rejections under 35 U.S.C. § 102

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,715,003 to Safai (hereinafter "Safai"). Applicant respectfully traverses this rejection in view of the following comments.

Turning to the cited reference, Safai is no different from the conventional technique discussed in the background of the invention. In general, Sakai teaches a handheld digital

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camera that can send to the photo service provider one or more digital images with address information e.g., one or more address image created in the camera, indicating destinations for the digital images or photographic prints. One or more additional images or instructions associated with the delivery addresses can indicate the size or quantity of the prints to be delivered. The camera can be coupled to a data communication network through which the camera directly sends the selected images to the photo service provider. At a server of the service provider, one or more photographic prints of the selected images are automatically printed, packaged, and sent to the delivery addresses (see *Abstract*; col. 3, lines 20 to 46).

For example, Safai teaches that the CPU 210 can execute a transport application 230, an edit application 232, a print application 234, and a camera control application 236. Generally, the transport application 230 can provide image transport functions, enabling a user of the digital camera 100 to send one or more stored pictures or images from the camera to one or more external addresses. The edit application 232 can provide image editing functions, enabling a user of the digital camera 100 to edit, retouch, or alter one or more stored pictures or images while they are stored in the camera. The print application 234 can provide image printing functions, enabling a user of the digital camera 100 to print one or more stored images directly from the camera to a printer. The camera control application 236 can provide camera control functions, enabling a user of the digital camera 100 to adjust settings of the camera such as the exposure time, flash on/off, zoom, whether manual focus or autofocus is enabled, red eye removal, flash fill, exposure intensity, etc. (Fig. 2; col. 7, lines 37 to 56).

In Safai, similar to the conventional techniques described in the background of the invention, the user has to select the application, and from this application the user has to navigate

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through a number of menus in order to transport, edit, or print the image (Figs. 3A-4I; col. 7, line 65 to col. 16, line 50).

Turning to the rejection, of these rejected claims, only claim 1 is independent. The Examiner contends that Safai teaches each feature of independent claim 1. This rejection is not supportable for at least the following reasons. First, claim 1 recites a dedicated interface unit for accepting input or edit of a preset data regarding the image data by one operation when the image data stored in the nonvolatile recording medium is displayed on the display unit. The Examiner alleges that Safai's Fig. 10 teaches a dedicated interface as set forth in claim 1 (see page 3 of the Office Action). This ground of rejection is respectfully submitted to be incorrect as a technical matter.

Safai, however, is not different from the prior art described in the application. In Safai, the user has to switch to the appropriate application and go through a number of menus and screens to transport the image (col. 7, line 65 to col. 8, line 34). In particular, Safai's Fig. 10 is a diagram of a selection screen 1000 that may be displayed by camera 100 as part of a block 215. The selection screen 1000 includes an image identifier field 1002 that displays the name or other identifier of one or more images, size selection fields 1004, 1006, and 1008 in which the user may enter the desired quantity of a particular size of photographic prints. Each size selection field 1004, 1006, and 1008 accepts a numeric entry, and may include up and down single-step buttons 1009 that may be used to increase or decrease the numeric entry by integer values of "1."

In Safai, however, it is not the image data that is displayed but image ID. That is, in Fig. 10 of Safai, the selection screen 1000 shows that in field 1002, instead of the image data, Photo: "#4 Sally" is displayed. That is, field 1002 displays the name or other identifier of one or more

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images and not the image data. Moreover, Safai, fails to teach or suggest accepting input or edit of a preset data by one operation. In Safai, one of the screens for the editing of data, the selection screen 100, includes at least the size and quantity selections. That is, in Safai, input and edit of the preset data is clearly not performed with a single operation.

Therefore, "a dedicated interface unit for accepting input or edit of a preset data regarding the image data by one operation when the image data stored in the nonvolatile recording medium is displayed on the display unit" as set forth in claim 1 is not suggested or taught by Safai. The teachings of the Safai lack having a dedicated interface unit which accepts input or edit of the preset data with one operation and performs this operation when the image data is displayed. In summary, the deficiencies of the Safai fall to the Examiner's burden to show inherent inclusion of the claim elements. Therefore, for all the above reasons, independent claim 1 is patentable. Claim 2-6 are patentable at least by virtue of their dependency on claim 1.

In addition, dependent claim 5 recites: "the push button switch is provided on the left with respect to the display unit." The Examiner alleges that this unique feature is taught in Fig. 4 by the element "cancel" (see page 4 of the Office Action). Safai, however, only teaches the operation of the image transport application 230 includes displaying a transport menu. An example of such is illustrated by the transport menu screen 404, which includes one or more transport type buttons 406a-d (Fig. 4A; col. 8, lines 1 to 18). In other words, in Safai, the transport menu is displayed in the display screen.

Moreover, if, as alleged by the Examiner, that the selection screen displayed in Fig. 10 is equivalent to the dedicated interface, *i.e.*, the push switch button (see claim 4), then clearly the selection screen displayed on a display such as an LCD display is not to the left of the display.

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As is clearly visible from Fig. 10 of Safai, the buttons "cancel, back, and next," which possibly correspond to the selection buttons 112 shown in Fig. 1. These selection buttons 112 are below the display and not to the left of the display. For at least these additional exemplary reasons, it is respectfully submitted that claim 5 is patentably distinguishable from Safai.

Finally, with respect to claim 6, the Examiner appears to equate Sakurai's CPU to the second memory unit, as set forth in claim 6 (see page 4 of the Office Action). This ground of rejection is respectfully submitted to be inaccurate for at least the following reasons. The CPU is commonly known as a processing unit and not as a memory unit. CPU is for processing of data, executing functions in the application, etc. CPU, however, cannot be equated with the memory unit that will store a copy of the preset data. Moreover, although the CPU may have registers, it is not inherent that the preset data is stored in these registers by the CPU.

Under the doctrine of "inherency," if an element is not expressly disclosed in a prior art reference, the reference will still be deemed to anticipate a subsequent claim if the missing element "is necessarily present in the thing described in the reference" *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." (emphasis added) *Trintec Indus., Inc. v. Topeka U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 U.S.P.Q.2d 1597, 1599 (Fed. Cir. 2002); see also MPEP §2112.

To show inherency in the present case, the Examiner relies on col. 7, lines 14-19 of Safai. The relied passage of Safai, however, only teaches that the CPU executes an operating system but it does not teach or suggest that the preset data (allegedly equivalent to the fields of the

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selection screen 1000, Fig. 10) are stored in registers of the CPU. By way of an example, it is possible that the preset data is pulled into the CPU for processing by portions. Alternatively, the CPU may simply query the storage 212 for the needed data. In other words, contrary to the allegations by the Examiner, Safai does not teach, suggest, or render inherent the second storage unit for storing preset data during input and/or edit of the preset data as set forth in claim 6. In short, it is not a must that all of the preset data will be stored in the registers of the CPU. For at least this additional reason, claim 6 is patentably distinguishable from Safai.

VI. New Claims

In addition, in order to provide more varied protection and to further distinguish the invention from the prior art reference cited by the Examiner, Applicant adds claims 7 to 16. Claims 7 to 13 are patentable at least by virtue of their dependency on claim 1. Claim 14 is patentable at least by virtue of its recitation of "a user edits or inputs the preset data by a single rotation of the dial or a single push of the button without changing or disrupting the displayed image data," and claims 15 and 16 are patentable at least by virtue of their dependency on claim 14.

VII. Conclusion

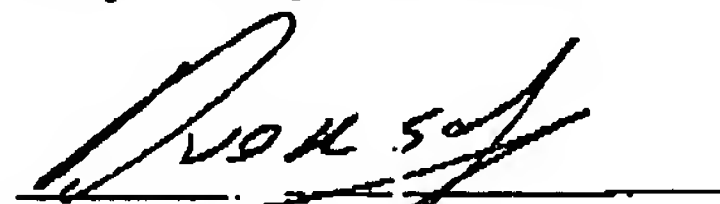
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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